

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Pereira et al.	Art Unit :	1656
Patent No. :	7,423,018	Examiner :	Monshipouri, Maryam
Issue Date :	September 9, 2008	Conf. No. :	5625
Serial No. :	10/735,972		
Filed :	December 15, 2003		
Title :	KINESIN-LIKE PROTEINS AND METHODS OF USE		

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)**

Applicants hereby petition for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent application. The Issue Notification mailed August 20, 2008, for the above-referenced application indicates that the Patent Term Adjustment at issuance is 452 days. Reconsideration of the Patent Term Adjustment calculation to increase PTO Delay from 673 days to 949 days, and to increase Total PTA from 452 to 726 days, is respectfully requested.

**CERTIFICATE OF MAILING BY EFS-WEB FILING**

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: November 10, 2008

### **REVIEW OF PATENT TERM ADJUSTMENT CALCULATION**

A review of the Patent Term Adjustment History in the PAIR system shows that the United States Patent and Trademark Office (PTO) calculated the Patent Term Adjustment (PTA) as follows:

- 1) The PTO mailed a Notice to File Missing Parts on March 30, 2004. Applicants submitted a Response to Notice to File Missing Parts on July 28, 2004. The Response was received at the PTO and date-stamped on July 30, 2004. The PAIR system indicates "Additional Application Filing Fees" on July 28, 2004, thereby according an Applicant Delay of 28 days. Applicants respectfully submit that the PTO's calculation of Applicant Delay contains an error and that the correct Applicant Delay is 30 days.
- 2) The PTO mailed a delayed 14-month first non-final Office Action on December 27, 2005, thereby according a PTO Delay of 315 days. Applicants do not dispute herein this patent term adjustment calculation for this PTO "A Delay."
- 3) Applicants filed an Information Disclosure Statement on August 31, 2006 (received at the PTO on August 31, 2006). Applicants were accorded a delay of 73 days for a supplemental response. Applicants do not dispute herein this patent term adjustment for Applicant Delay.
- 4) Applicants submitted an Issue Fee Payment on May 14, 2007 (received at the PTO on May 17, 2007), after which the Office issued the patent on September 9, 2008, thereby according a PTO Delay of 358 days for late issuance of the patent (after four months from issue fee payment). Applicants do not dispute herein the patent term adjustment calculation for this PTO "A Delay."
- 5) Applicants submitted a Response to Notice to File Corrected Application Papers after allowance on May 14, 2007 (received at the PTO on May 17, 2007), to which the Office did not respond within 120 days. Accordingly, an Applicant Delay of 120 days was assessed, and Applicants do not dispute herein the patent term adjustment calculation for this Applicant Delay.

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- 6) The application was filed on December 15, 2003 and the patent issued on September 9, 2008, more than three years later. No PTO Delay was calculated for issuance of the patent after three years from filing. Applicants respectfully submit that the PTO's calculation of this PTO "B Delay" contains an error and that the correct PTO Delay for issuance beyond three years from filing is 634 days, as outlined further below.

### **REMARKS**

Applicants have calculated the PTA in accordance with the clear intent of Congress. As outlined in Wyeth v. Dudas (Wyeth et al. v. Jon W. Dudas, U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008), the only way that periods of time can “overlap” is if they occur on the same day, and if an “A delay” occurs on one calendar day and a “B delay” occurs on another, they do not overlap, and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. “A Delays” are defined as delays by the Office under 35 U.S.C. 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than 3-year application pendency.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, relies on the premise that the application was delayed under § 154(b)(1)(B) before the initial three-year period expired.

The Wyeth court determined that this construction cannot be squared with the language of § 154(b)(1)(B), which applies “if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years,” and that “B delay” begins once the PTO has failed to issue a patent within three years, not before.

In the current PTA calculation, the Office has only given credit for the larger of “A Delay” or “B Delay,” rather than the combined sum of “A Delay” and “B Delay” (which does not include any days after three years from filing where “A” and “B” delays overlap).

In this patent, “A Delay” should be calculated as 315 days and “B Delay” should be calculated as 634 days. Thus, the total PTO Delay should be calculated as 949 days.

In consideration of the events described above, Applicants believe the PTA calculation of 452 days is incorrect. As such, Applicants respectfully request reconsideration of the patent term adjustment in the following manner:

- 1) Total PTO Delay should be calculated as 949 days;
- 2) Total Applicant Delay should be calculated as 223 days; and
- 3) Total PTA should be calculated as 726 days.

Applicants note that this patent is not subject to a terminal disclaimer.

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Please apply the fee of \$200 required under 37 C.F.R. § 1.18(e) and any other required charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket Number 07917-0198001.

Respectfully submitted,

Date: November 10, 2008

/RSMcQuade/

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